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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,222	01/16/2004	Hirosuke Otaki	K-2139	5745

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EXAMINER

FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,222

Applicant(s)

OTAKI ET AL.

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species a: figures 1-3 in filed April 14, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 a frame is recited with "an opening portion at a center containing therein a gas". It is unclear if the center portion or frame contains a gas.

In claim 4, the frame body is recited as "formed to be freely foldable". The scope and content of the language is indefinite as it is not clear what one considers being freely foldable. Also it is not clear if applicant is invoking 112, 6th paragraph in the "holding means" recited.

If 112, 6th is being invoked, applicant must identify every means plus function involved in the claims with a concise explanation of the subject matter defined, referring the to specification by page number and line, and to the drawings, and set for the structure, material, or acts described in the specification corresponding to each claimed function with referent to the specification by page and line number, and to the drawing to be considered responsive. This is done to establish the prosecution history in accordance with 37 CFR 41.37(c)(1)(v).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by De Harak (Patent no. 3,771,247). A shock absorber is disclosed comprising a frame 12 including an opening provided at a center portion containing a gas therein. A member 14 is provided in the frame 12 so as to cross said opening portion of the frame body and supporting a package target, the art object contained in member 14.

As to claim 3, member 14 can be characterized as a bag.¹

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (Patent no. 2,681,142). A shock absorber is disclosed comprising a frame 1, 2 including an opening provided at a center portion containing a gas therein. A member 4 (which can be considered either of the diaphragms 4, or both diaphragms 4 collectively) is provided in the frame 1, 2 so as to cross the opening portion of the frame body and supporting a package target, the object contained in member 14.

As to claim 2, a first opening edge is located on one side of the frame 1 defined radially inward of flange 3. A second opening edge is also located at the other side of side frame 2 radially inward of flange 3. The member 4 is connected to an inner wall, defined by the planar surface of the flange 3, between the first opening and the second opening edge so as to cross the opening portion of the body frame, see figures 2, 6 and 10.

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As to claim 3, member 14 can be characterized as a bag.

As to claim 4 one frame-shaped side body 1 is formed to be foldable, bent over another part 2. As previously described member 4 can be considered a bag in as much as is claimed and disclosed. An opening of the bag, which is the outer circumference of member 4 is closed by the frame body with “holding means” 10.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Adkins (Patent no. 6,5132,681,142). In a similar vein as described with Cohen, a shock absorber is disclosed comprising a frame shaped body defined by frame members 12, 14 including an opening provided at a center portion containing a gas therein. A member 38, 40 is provided in the frame so as to cross the opening portion of the frame body and supporting a package target 52.

As to claim 2, the member 38, 40 is connected to an inner wall between a first opening and a second opening edge so as to cross the opening portion of the body frame, see col. 4, lines 4-6.

As to claim 3, member 14 can be characterized as a bag.

As to claim 4 one frame-shaped side body 12 is formed to be foldable, bent over another part 14. As previously described member 38, 40 can be considered a bag in as much as is claimed and disclosed. The frame body with “holding means” 26, 28, see col. 3, line 51.

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

7. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: “The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims “define a patentable invention” without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, “The

¹ A container of flexible material, such as paper, plastic, or leather that is used for carrying or storing items, dictionary.com.

prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims.” Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)” (emphasis mine), see MPEP 706.07(a).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei
Primary Examiner
Art Unit 3728

dtf
April 27, 2006